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PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			HORNBERGER, JENNIFER LEA	
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			02/18/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/579,014

**Applicant(s)**

KUHNS ET AL.

**Examiner**

JENNIFER L. HORNBERGER

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/US)  
Paper No(s)/Mail Date 12/11/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5, 9-12, 20, 21, 24-26, 32, 35-38, 41-43, and 51-53 are rejected under 35

U.S.C. 103(a) as being unpatentable over Kerr (US 2006/0079925) in view of Pena (US 5,178,133).

Regarding claims 1, 9-11, and 35-37, Kerr discloses a diagnostic device for pathologies of tubular anatomical structures comprising: a tubular elongated structure (12) developing between a proximal end and a distal end (12a) and being adapted to be inserted in the tubular anatomical structure (Fig. 1-2), means (26) for locally dilating the walls of the tubular anatomical structure being associated with the distal end of said elongated structure, said means for locally dilating being movable between a closed position (Fig. 1) for the introduction of the device and at least one open position (Fig. 2) for the viewing and evaluation of the pathology, a control means (14,22) being associated to the proximal end of the elongated structure, said control means being operatively connected to said means for locally dilating in order to move them between the closed position and the open position (paragraph 51), and vice versa. Kerr fails to disclose the means for locally dilating comprises a continuous membrane for engaging dilating tissue in a continuous manner. Pena discloses a means for locally dilating (12) comprising a continuous transparent elastic membrane (34) covering dilating arms (12) for allowing the surgeon optimal viewing of the surgical field (see abstract). It would have been obvious to one of ordinary skill in the art to modify Kerr to include a continuous transparent elastic membrane

covering the means for locally dilating as suggested by Pena to evenly dilate the anatomical structure.

Regarding claim 2, Kerr discloses a means of viewing (16) adapted to be associated with the elongated tubular structure and reach the tract of the tubular anatomical structure dilated by the means of dilating (Fig. 1-2).

Regarding claim 3, Kerr discloses the elongated tubular structure (12) is internally hollow in order to receive the means of viewing (Fig. 1-2).

Regarding claims 4 and 32, Kerr discloses said means for locally dilating comprise petals or arms (26) being arranged such that one first end thereof is associated to the distal end of the elongated tubular structure, said petals being adapted to assume at least one closed configuration (Fig. 1) and one open configuration (Fig. 2).

Regarding claim 5, Kerr discloses a petal (26) comprises an arm which broadens into a curved surface (Fig. 1-2).

Regarding claims 12, 38, and 49, Kerr discloses said elongated structure comprises an inner tube (20) and an outer tube (12) adapted to internally receive said inner tube, said inner tube and said outer tube being suitable to translate relatively to each other to open or close said petals (paragraph 51).

Regarding claim 20, Kerr discloses said petals (26) are formed as one piece with said outer tube (12).

Regarding claim 21, Kerr discloses each petal (26) couples with a portion of said inner tube (20a) forming a unidirectional guide adapted to close or open the petals subsequent to the translation of the inner tube relative to the outer tube and the petals.

Regarding claims 24, 41, and 51, Kerr discloses said inner tube (20) comprises a holding body (22) arranged at a proximal end of the inner tube and wherein said outer tube (12)

comprises a further holding body (14) being arranged at a proximal end of the outer tube (Fig. 1-2).

Regarding claims 25, 42, and 52, Kerr discloses said holding body (22) is made in the shape of a handle (Fig. 1-2).

Regarding claims 26, 43, and 53, Kerr discloses said holding body (14) comprises a setting ring (14a) to define the position of the holding body (34) corresponding to an open configuration of the device (paragraph 50).

2. Claim 8, 13, 34, 39, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerr (US 2006/0079925) in view of Pena (US 5,178,133) as applied to claims 4, 12, 32, 38, or 49 above, and further in view of Bertolero et al. (US 2005/0159645).

Kerr fails to disclose a petal and outer surface of the outer tube comprise at least one detection element or marker. However, Bertolero et al. disclose a detection element or marker on an outer sheath (paragraph 8) for determining the location in the body. It would have been obvious to provide a detection elements or radiopaque marker on the outer tube and/or on at least one petal to allow the location of the device in the body to be determined.

3. Claims 1, 4, 12, 24, 27-29, 32, 38, 41, 44-46, 49, 51, and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nady-Mohamed (US 5,353,784) in view of Pena (US 5,178,133).

Regarding claim 1, Nady-Mohamed discloses a diagnostic device for pathologies of tubular anatomical structures comprising: a tubular elongated structure (10) developing between a proximal end and a distal end and being adapted to be inserted in the tubular anatomical structure, means (13,14) for locally dilating the walls of the tubular anatomical structure being associated with the distal end of said elongated structure, said means for locally dilating being movable between a closed position (Fig. 1) for the introduction of the device and at least one

open position (Fig. 2) for the viewing and evaluation of the pathology, a control means (40) being associated to the proximal end of the elongated structure (Fig. 4), said control means being operatively connected to said means for locally dilating in order to move them between the closed position and the open position (col. 4, ln. 53-66), and vice versa. Nady-Mohamed disclose the means for locally dilating comprises a membrane for engaging dilating tissue in a continuous manner, but fails to disclose the membrane is continuous. Pena discloses a means for locally dilating (12) comprising a continuous transparent elastic membrane (34) covering dilating arms (12) for allowing the surgeon optimal viewing of the surgical field (see abstract). It would have been obvious to one of ordinary skill in the art to modify Nady-Mohamed to substitute the non-continuous membrane with a continuous transparent elastic membrane covering the means for locally dilating to achieve the same predictable result as evenly dilating the surrounding tissue in the surgical field. Substitution of one known element for another element providing the same function to yield predictable results would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claims 4 and 32, Nady-Mohamed discloses said means for locally dilating comprise petals or arms (13,14) being arranged such that one first end thereof is associated to the distal end of the elongated tubular structure, said petals being adapted to assume at least one closed configuration (Fig. 1) and one open configuration (Fig. 2).

Regarding claims 12, 38, and 49, Nady-Mohamed discloses said elongated structure comprises an inner tube (11) and an outer tube (10) adapted to internally receive said inner tube, said inner tube and said outer tube being suitable to translate relatively to each other to open or close said petals (col. 4, ln. 53-56).

Regarding claims 24, 41, and 51, Nady-Mohamed discloses said inner tube (11) comprises a holding body (18) arranged at a proximal end of the inner tube and wherein said

outer tube (10) comprises a further holding body being arranged at a proximal end of the outer tube (Fig. 4).

Regarding claims 27, 44, and 54, Nady-Mohamed discloses the holding body further comprises at least one rib (61) to define at least one position of the holding body corresponding to an intermediate open configuration of the device (Fig. 7; col. 27-43).

Regarding claims 28, 45, and 55, said outer tube (10) comprise a holding body (40) being arranged at a proximal portion of the tube, said holding body (41) comprising a first portion and a second portion (42), suitable to rotate relative to the first portion, and wherein there are further comprised means for turning the rotational movement of the first portion to a translational movement of the inner tube (11; col. 4, ln. 62 – col. 5, ln.11).

Regarding claims 29, 46, and 56, said outer tube (10) comprises a holding body (41) being provided with a trigger (42) adapted to rotate relative to the holding body and wherein there are provided means for turning the rotational movement of the trigger in a translational movement of the inner tube (11; col. 4, ln. 62 – col. 5, ln.11).

4. Claims 31, 48, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nady-Mohamed (US 5,353,784) in view of Pena (US 5,178,133) as applied to claims 29, 46, and 56 above, and further in view of Lapkin et al. (US 3,667, 474). Nady-Mohamed fails to disclose an elastic means being interposed between the holding body and the trigger to withdraw the latter in the resting position. Lapkin et al. disclose elastic means (30) interposed between a holding body (25) and a trigger member (26) for returning the inner member and holding members to their initial positions. It would have been obvious to one of ordinary skill in the art to provide Nady-Mohamed with an elastic member interposed between the holding member and the trigger member to provide an elastic force to return the members to their initial position as disclosed by Lapkin et al.

5. Claims 30, 47, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nady-Mohamed (US 5,353,784) in view of Pena (US 5,178,133) as applied to claims 29, 46, and 56 above, and further in view of Williamson, IV et al. (US 5,972,004). Nady-Mohamed fails to disclose said trigger (212) comprises a toothed area (216) suitable to couple with a proximal grooved length (204), or a threaded length of the inner tube (202). Williamson et al. disclose a trigger (212) comprises a toothed area (216) suitable to couple with a proximal grooved length (218) of the inner tube for advancing a cutter distally (col. 16, ln. 27-30). It would have been obvious to substitute the coupling between the trigger to the inner tube in the device of Nady-Mohamed with the gear on the trigger and a rack on inner tube to achieve the same predictable result of trigger member causing the inner tube to move distally. Substitution of one known element for another element providing the same function to yield predictable results would have been obvious to one of ordinary skill in the art at the time of the invention.

6. Claims 1, 4-7, 12, 20-23, 32, 33, 38, 40, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ewerhardt et al. (US 1,950,788) in view of Pena (US 5,178,133) and Nady-Mohamed (US 5,353,784).

Regarding claim 1, Ewerhardt et al. disclose a diagnostic device for pathologies of tubular anatomical structures comprising: a tubular elongated structure (10) developing between a proximal end and a distal end and being adapted to be inserted in the tubular anatomical structure, means for locally dilating (12) the walls of the tubular anatomical structure being associated with the distal end of said elongated structure, said means for locally dilating being movable between a closed position (Fig. 1) for the introduction of the device and at least one open position (Fig. 2) for the viewing and evaluation of the pathology, control means (21) being associated to the proximal end of the elongated structure, said control means being operatively connected to said means for locally dilating in order to move them between the closed position



and the open position, and vice versa (col. 3, ln. 47-51). Ewerhardt et al. fail to disclose a continuous membrane. Nady-Mohamed disclose a means for locally dilating (13,14) comprises a membrane (20) for engaging dilating tissue in a continuous manner, but fails to disclose the membrane is continuous. Pena discloses a means for locally dilating (12) comprising a continuous transparent elastic membrane (34) covering dilating arms (12) for allowing the surgeon optimal viewing of the surgical field (see abstract). It would have been obvious to one of ordinary skill in the art to modify Ewerhardt et al. to include a continuous transparent elastic membrane covering the means for locally dilating to evenly dilate the surrounding tissue in the surgical field as suggested by Pena and Nady-Mohamed.

Regarding claims 4 and 32, Ewerhardt et al. disclose the means for locally dilating comprise petals (12) being arranged such that one first end thereof is associated to the distal end of the elongated tubular structure, said petals being adapted to assume at least one closed configuration (Fig. 1) and one open configuration (Fig. 2).

Regarding claim 5, Ewerhardt et al. disclose a petal comprises an arm which broadens into a curved surface (Fig. 2).

Regarding claim 6, Ewerhardt et al. disclose said curved surface has an asymmetric conformation with respect to the respective arm (Fig. 1).

Regarding claim 7, Ewerhardt et al. disclose said curved surface comprises a side extension suitable to overlap to the adjacent petal at least in the closed configuration of the petals (Fig. 1).

Regarding claims 12, 38, and 49, Ewerhardt et al. disclose said elongated structure comprises an inner tube (21) and an outer tube (10) adapted to internally receive said inner tube, said inner tube and said outer tube being suitable to translate relatively to each other to open or close said petals (col. 3, ln.15-19).

Regarding claim 20, Ewerhardt et al. disclose said petals (12) are formed as one piece with said outer tube (10; Fig. 1).

Regarding claim 21, Ewerhardt et al. disclose each petal (12) couples with a portion of said inner tube (21) forming a unidirectional guide adapted to close or open the petals subsequent to the translation of the inner tube relative to the outer tube and the petals (Fig. 2).

Regarding claim 22, Ewerhardt et al. disclose each petal (12) comprises a longitudinally extending rib (17) and wherein said inner tube (21) comprises a distal flange (15) provided with openings (16) adapted to couple with respective ribs (17) of said petals (col. 2, ln. 105-120).

Regarding claim 23, Ewerhardt et al. fail to disclose wherein said rib (17) has a T-shaped cross-section and wherein said openings has a C-shaped cross-section suitable to couple with the cross-section of a respective rib. It would have been an obvious matter of design choice to give the rib a T-shaped cross section and the openings of the inner tube of the distal flange a C-shaped cross section, since applicant has not disclosed that the particular coupling solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the ribs and the openings having any shaped cross-sections which fit together.

Regarding claim 33, Ewerhardt et al. disclose at least one arm comprises a straight length suitable to be fixed to the elongated structure and a curved length (Fig. 2).

Regarding claim 40, Ewerhardt et al. disclose an outer surface of the outer tube (10) has grooves (11) adapted to receive at least one portion of an arm (12), respectively (Fig. 1).

7. Claims 1, 4, 12, 14-19, 32, 38, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sijp (DE 19828099 A1) in view of Pena (US 5,178,133) and Nady-Mohamed (US 5,353,784).

Regarding claim 1, Sijp discloses a diagnostic device for pathologies of tubular anatomical structures comprising: a tubular elongated structure (1) developing between a proximal end and a distal end and being adapted to be inserted in the tubular anatomical structure, means for locally dilating (3) the walls of the tubular anatomical structure being associated with the distal end of said elongated structure, said means for locally dilating being movable between a closed position (Fig. 1) for the introduction of the device and at least one open position (Fig. 2) for the viewing and evaluation of the pathology, control means (5,6) being associated to the proximal end of the elongated structure, said control means being operatively connected to said means for locally dilating in order to move them between the closed position and the open position, and vice versa (Fig. 4-5). Sijp fails to disclose a continuous membrane. Nady-Mohamed disclose a means for locally dilating (13,14) comprises a membrane (20) for engaging dilating tissue in a continuous manner, but fails to disclose the membrane is continuous. Pena discloses a means for locally dilating (12) comprising a continuous transparent elastic membrane (34) covering dilating arms (12) for allowing the surgeon optimal viewing of the surgical field (see abstract). It would have been obvious to one of ordinary skill in the art to modify Ewerhardt et al. to include a continuous transparent elastic membrane covering the means for locally dilating to evenly dilate the surrounding tissue in the surgical field as suggested by Pena and Nady-Mohamed.

Regarding claims 4 and 32, Sijp discloses the means for locally dilating comprise petals (3) being arranged such that one first end thereof is associated to the distal end of the elongated tubular structure, said petals being adapted to assume at least one closed configuration (Fig. 1) and one open configuration (Fig. 2).

Regarding claims 12, 38, and 49, Sijp discloses said elongated structure comprises an inner tube (10) and an outer tube (1) adapted to internally receive said inner tube, said inner

tube and said outer tube being suitable to translate relatively to each other to open or close said petals (Fig. 4-5).

Regarding claim 14, Sijp discloses said inner tube (1) has an annular groove adapted to receive and draw an end of said petals (3; Fig. 3-5).

Regarding claim 15, Sijp discloses said outer tube (10) has openings to receive said petals (Fig. 3-5).

Regarding claim 16, Sijp discloses at an opening said outer tube (10) comprises a notch suitable to be inserted inside an aperture (4) of a respective petal (3).

Regarding claim 17, Sijp discloses said inner tube (1) has a distal grooved length or a threaded length adapted to receive and draw an end of a petal (3) comprising a toothed area (8; Fig. 3).

Regarding claim 18, Sijp discloses said outer tube (218) has openings to receive said petals (Fig. 4-5).

Regarding claim 19, Sijp discloses wherein at an aperture said outer tube (218) has seats (4) adapted to receive a pivot (8) of a corresponding petal (3; Fig. 3-5).

### ***Response to Arguments***

8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh  
02/11/2009

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